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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,046	02/14/2002	James W. Rodgers	028282.0001	1585

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,046

Applicant(s)

RODGERS ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10,12,15-17 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 3-7,9,11,13,14 and 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0202.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1, 2, 10, 12, 15-17, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palcher (U.S. Patent No. 3,956,174) and Hyde et al. (U.S. Patent No. 2,891,920).

For claims 1 and 2, in column 2, lines 12-17, Palcher teaches a preservative composition that contains an emulsion of organopolysiloxane and water, where a polyol (applicant's component (b)) has been added to the emulsion corresponding to applicant's component (a)(1). In column 3, lines 48-65, Palcher prefers a dimethylsilicone fluid. For claim 8, in column 5, lines 11-20, Palcher teaches that the emulsion usually contains dimethylpolysiloxane, emulsifier, and water. For claim 10, here Palcher discloses that the emulsifier is nonylohenol, a non-ionic surfactant. For claim 12, Palcher also teaches that the emulsions typically contain from 35% to 50% of the silicone fluid which is within applicant's range. For claims 15 and 16, in column 4, lines 36-44, Palcher teaches that the viscosity of the fluids are from 100 to 10,000 centistokes, which largely overlaps applicant's range. For claims 23 and 24, in column 5, lines 32-43, Palcher teaches the use of 1,2,3-propanetriol as the polyol. For claims 25 and 26, Palcher teaches the application of the composition to rubbers, plastics, wood, and leather.

For claim 1, in column 1, lines 34-45, Hyde teaches emulsified polysiloxanes that are used as protective coatings, i.e. elastomeric films corresponding to applicant's component (a)(1). For claims 17, 21, and 22, Hyde teaches in column 3, line 50 through column 4, line 12, that there is an emulsifier present that can be nonionic. In

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column 4, lines 3-12, Hyde teaches ethoxylated alkyl-phenols. In column 1, lines 52-64, Hyde teaches the addition of water to the emulsion.

Palcher fails to teach the presence of the emulsified polyorganosiloxane (a)(2). Hyde fails to teach the presence of the emulsified polyorganosiloxane (a)(1). Palcher and Hyde are analogous art in that they both teach polysiloxane emulsions used as protective coatings. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the compositions of Palcher and Hyde to form a protective coating. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. . . . [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)

Allowable Subject Matter

5. Claims 3-7, 9, 11, 13, 14, and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For claims 3-7, the references do not teach or suggest the percentages of the components set forth in those claims. In addition, neither reference teaches the particle sizes of the emulsions set forth by applicant. For claims 9 and 11, Palcher does not teach or suggest the use of ionic surfactants, or the nonionic surfactants set forth in claim 11. For claims 18 and 19, the percentage of organopolysiloxane is not taught or suggested by Hyde.

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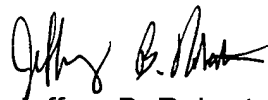
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Traver et al. (U.S. Patent No. 4,600,436), Gordon (U.S. Patent No. 4,997,478), Greenleaf et al. (U.S. Patent No. 5,462,587), Burke et al. (U.S. Patent No. 5,782,962), Jackson et al. (U.S. Patent No. 5,866,532), Muntz et al. (U.S. Patent No. 6,221,433) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR